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10/720,077	11/25/2003	Jong Seok Kim	0465-1081P	4939
2292 7590 01/08/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER HECKERT, JASON MARK				
ART UNIT		PAPER NUMBER		
1792				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JONG SEOK KIM,  
YANG HWAN NO, HAN KI CHO, YEON SU JUNG,  
JUNG HOON KANG, MYUNG SIK PARK  
and  
YOUNG HOON HA

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Application No. 10/720,077  
Technology Center 1700

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Mailed: January 7, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.  
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on November 12, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

### **APPEAL BRIEF, ARGUMENTS**

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed January 9, 2008 under the heading “Argument” have not been clearly provided. Each grounds of rejection must be treated under a **separate heading** in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellants have not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8<sup>th</sup> ed. Rev. 6, September 2007) for details.

### **EXAMINER’S ANSWER, EVIDENCE RELIED UPON**

Section §1207.02 of the MPEP states:

(A) CONTENT REQUIREMENTS FOR EXAMINER’S ANSWER. The examiner’s answer is required to include, under appropriate headings, in the order indicated, the following items:

....

- (8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer mailed April 16, 2008 is deficient because the "Evidence Relied Upon" section fails to include the Fuse reference cited on page 3 in the Examiner's Answer's grounds of rejection of claims 8 and 12 under 35 U.S.C. § 103(a). It should be noted that Fuse was not included in the discussion of this rejection appearing on pages 4 and 5.

Appropriate correction is required.

**EXAMINER'S ANSWER, INCONSISTENCY IN GROUNDS OF  
REJECTION**

The "Grounds of Rejection to be Reviewed on Appeal" includes a new ground of rejection of "claims 5 and 9 . . . under 35 U.S.C. 102(e) as being anticipated by Mayer et al. (Mayer)" [page 3]. However, the discussion of this ground of rejection appearing on page 5 lists this rejection as involving claims 5 and 7. Clarification is required regarding the claims involved in the § 102(e) rejection.

**CONCLUSION**

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on January 9, 2008 defective;
- 2) to notify Appellants to file a paper properly presenting the arguments for each grounds of rejection as required;

- 3) for consideration of said paper;
- 4) to vacate the Examiner's Answer mailed April 16, 2008;
- 5) to generate a revised Examiner's Answer correctly setting forth the "Evidence Relied Upon" section and to correct other sections of the Answer as may be required;
- 6) for clarification regarding the claims involved in the new § 102(e) rejection as being anticipated by Mayer et al (Mayer);
- 7) to include the approval of the Technology Center (TC) Director or his/her designee<sup>1</sup> as required for new grounds of rejection; and
- 8) for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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<sup>1</sup> In TC 1700, only a TC Director or Quality Assurance Specialist may approve new grounds of rejection.